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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,293	08/14/2006	Debbie Stevens-Wright	B1075.71014US01	1875
23628 7590 04/28/2010 WOLF GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210-2206				
EXAMINER				
LEE, BENJAMIN HYOUNGSOI				
ART UNIT		PAPER NUMBER		
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04/28/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/551,293

**Applicant(s)**

STEVENS-WRIGHT ET AL.

**Examiner**

BENJAMIN LEE

**Art Unit**

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7,11-13,16-19 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-7 and 33 is/are allowed.
- 6) ☒ Claim(s) 11-13,16-19,32 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In response to the amendment filed on 2/22/2010, claims 1, 3-7, 11-13, 16-19 and 32-34 are pending, and claims 2, 8-10, 14-15, 20-31 are canceled.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 18** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble and previous claims are directed towards an ablation electrode, not a combination of the electrode with a catheter. Now, applicant positively claims the catheter making it unclear if applicant is claiming the subcombination or the combination. Applicant must clarify the scope of the claims by either amending the preamble to indicate the combination is being claimed, or by amending claim 18 to incidentally recite the catheter.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 11 and 34** are rejected under 35 U.S.C. 102(b) as being anticipated by Silvestrini (WO 95/20360).

**As to claim 11**, Silvestrini discloses a catheter with a longitudinal catheter shaft 5 (Fig. 3) for positioning an ablation electrode within a patient's body (pg. 1, ¶ 1). Silvestrini teaches an ablation electrode 2 (that inherently has a length) is disposed on the shaft 5, and the electrode 2 has a continuous outer ablating surface area with an outer ablating surface area length since the electrode's surface area is connected to an RF generator (see Fig. 3, pg. 8, ¶ 2). The continuous outer ablating surface area length and ablation electrode length (see Fig. 3) are adjustable since in one embodiment an insulating sheath slides relative to the electrode and adjustably exposes a portion of the electrode (page 3, line 33 – page 4 line 2) and in another embodiment the electrode portions are telescopically slidable relative to one another (pg. 8, ¶ 3), thus exposing or hiding surface area of the ablation electrode. Silvestrini discloses the electrode having portions which stay in electrical contact with one another (e.g. proximal and distal portions of the same electrode). Note that the limitation "the electrode having portions which stay in electrical contact with one another" is very broad and does not specify the structure of the portions. Silvestrini teaches the electrode is substantially comprised of metal since it is fabricated from conventional metallic electrode material (pg. 3, ¶ 3).

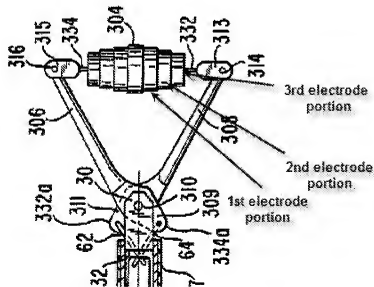
**As to claim 34**, Silvestrini teaches in Fig. 3 a catheter comprising: a longitudinal catheter shaft 5 for positioning an ablation electrode within a patient's body; and an electrically conductive element 2 disposed on the shaft and connectable to an energy supply, an exposed portion of the electrically conductive element being usable as an

ablation electrode, wherein the exposed portion of the electrically conductive element is convertible from a first configuration, in which the electrically conductive element has a first radial size along a first axial section of the shaft and a first axial length, to a second configuration in which the electrically conductive element has a second, longer axial length as compared to the first axial length, and maintains the first radial size along the first axial section of the shaft since in one embodiment an insulating sheath slides relative to the electrode and adjustably exposes a portion of the electrode (page 3, line 33 – page 4 line 2). In another embodiment, the electrode slides relative to another electrode (pg. 8, ¶ 3).

6. **Claims 16-17** are rejected under 35 U.S.C. 102(b) as being anticipated by Turkel (USPN 5,354,296).

**As to claim 16**, note that the preamble recites “an ablation electrode for ablating tissue” and does not explicitly recite a catheter or catheter shaft. Turkel discloses an ablation electrode for ablating tissue, comprising: a first ablation electrode portion (see Fig. 3a below) configured for mounting on a catheter shaft (the first electrode portion is capable of mounting on a catheter shaft), the first ablation electrode portion having an outer ablating surface configured to emit electrical energy (as implied in col. 2, lines 36-38); and a second ablation electrode portion (see Fig. 3a below) configured for mounting on the catheter shaft (the second electrode portion is capable of mounting on a catheter shaft), the second ablation electrode portion having an outer ablating surface configured to emit electrical energy (as implied in col. 2, lines 36-38); wherein the

second ablation electrode portion is moveable from a first position substantially inside the first ablation electrode portion to a second position substantially outside the first ablation electrode portion (see Fig. 3b).



**As to claim 17,** Turkel discloses a third ablation electrode portion (see Figure above) configured for mounting on the catheter shaft (the third electrode portion is capable of mounting on a catheter shaft), the third ablation electrode portion having an outer ablating surface configured to emit electrical energy (as implied in col. 2, lines 36-38), wherein the third ablation electrode portion is moveable from a first position substantially inside the second ablation electrode portion to a second position substantially outside the second ablation electrode portion (as seen by comparing Figs. 3a and 3b).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. **Claims 12-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Silvestrini (WO 95/20360), as applied to claim 11 above, in view of Eggers (U.S. Patent 5,810,764).

**As to claim 12**, Silvestrini does not expressly teach that the electrode is substantially comprised of at least one of platinum, silver, gold, chromium, aluminum and tungsten. However, Eggers teaches that electrodes for ablation comprise electrically conducting materials such as alloys containing one or more of platinum, chromium, aluminum or tungsten (col. 22, lines 49-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the electrode of Silvestrini such that it substantially comprised of at least one of platinum, silver, gold, chromium, aluminum or tungsten since suitable metallic materials for an ablation electrode is recognized in the art, as exemplified by the teachings of Eggers (col. 22, lines 49-53).

**As to claim 13**, Silvestrini does not expressly teach that the electrode is substantially comprised of a combination of at least two of: platinum; silver; gold;

chromium; aluminum and tungsten. However, Eggers teaches that electrodes for ablation comprise electrically conducting materials such as alloys containing one or more of platinum, chromium, aluminum or tungsten (col. 22, lines 49-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the electrode of Silvestrini such that it substantially comprised of a combination of at least two of platinum, silver, gold, chromium, aluminum or tungsten since suitable metallic combinations for an ablation electrode is recognized in the art, as exemplified by the teachings of Eggers (col. 22, lines 49-53).

9. **Claims 16, 18, 19 and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Silvestrini (WO 95/20360).

**As to claim 16**, Silvestrini discloses an ablation electrode 2 for ablating tissue, comprising: a first ablation electrode portion 2 configured for mounting on a catheter shaft 3a, the first ablation electrode portion having an outer ablating surface configured to emit electrical energy. While Silvestrini discloses a second ablation electrode, Silvestrini does not disclose it is a portion of the ablation electrode (e.g. monopolar). However, it is well known in the art to implement electrosurgical devices in either a bipolar or monopolar mode and it would have been obvious to one of ordinary skill in the art to implement the device of Silvestrini in a monopolar mode. With such a modification, the electrode of Silvestrini would include both electrode portions 2 and 4 (since its monopolar), where electrode portion 4 would be a second ablation electrode portion configured for mounting on the catheter shaft, the second ablation electrode



portion having an outer ablating surface configured to emit electrical energy; wherein the second ablation electrode portion is moveable from a first position substantially inside the first ablation electrode portion to a second position substantially outside the first ablation electrode portion (page 3, line 33 – page 4 line 2, see Figs. 1, 2 and 3).

**As to claim 18**, Silvestrini discloses the ablation electrode according to claim 16 in combination with a longitudinal catheter shaft for positioning an ablation electrode within a patient's body, wherein the first ablation electrode portion and the second ablation electrode portion are mounted on the catheter shaft (see Fig 3).

**As to claim 19**, Silvestrini teaches a wire that is connected to the second electrode portion (pg. 7, ¶ 2) and is capable of being pulled or pulling the second electrode portion since it steers the second electrode portion.

**As to claim 32**, the modified electrode of Silvestrini is such that the first ablation electrode portion and the second ablation electrode portion are electrically connected since it is modified to be monopolar.

***Allowable Subject Matter***

**Claim 1, 3-7, 33** are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN LEE whose telephone number is (571)270-1407. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571)-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. L./ 4/20/2010  
Examiner, Art Unit 3739

/Linda C Dvorak/  
Supervisory Patent Examiner, Art  
Unit 3739